

Application No. 10/715,562

REMARKS

Claims 1-43 are pending. By this Amendment, claim 30 is amended and claims 42 and 43 are added.

Applicant wishes to thank Examiner Nordmeyer for the courtesies extended to Applicant's representative, Caroline Dennison, during the personal interview on December 7, 2005. During the interview, the differences between the related copending applications and the differences between the claimed invention and the prior art were pointed out by Applicant's representative.

It is noted that the prior art citations provided by Applicant and returned with the Office Action were all signed by the Examiner but not every entry was initialed. It is presumed that each entry was considered as the Examiner's signature so indicates.

Submitted herewith is a Request for Correction of Patent Office Records to indicate that the provisional priority application is no. 60/491,252 as stated in paragraph [0001] of this application.

Obviousness-type Double Patenting Rejections

In the Office Action, claims 1-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

Claims 1-85 of copending application no. 10/821,202;

Claims 1-23 of copending application no. 10/880,607;

Claims 1-21 of copending application no. 11/023,412;

Claims 1-19 of copending application no. 11/023,413; and

Claims 1-20 of copending application no. 11/034,255.

The explanation for each rejection is virtually identical and merely states that both articles contain coverings for use on an exterior surface [sic: and] are made with fibrous layers,

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moldable layers and release sheets covering the back surface of the moldable layer. The rejections are improper in that they do not consider the specific limitations of each claim and do not present a prima facie case of obviousness, as required.

An analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). The following factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 must also be employed when making an obvious-type double patenting analysis. These factual inquiries include:

- (A) determining the scope and content of a patent (or application) claim relative to a claim in the application at issue;
- (B) determining the differences between the scope and content of the patent (or application) claim as determined in (A) and the claim in the application at issue;
- (C) determining the level of ordinary skill in the pertinent art; and
- (D) evaluating any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

- (A) the differences between the inventions defined by the conflicting claims (i.e., a claim in the patent (or application) compared to a claim in the application); and
- (B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

None of these determinations have been made in the Office Action, and in particular the differences between the claims have not been identified. Therefore, the rejections are improper and should be withdrawn.

Prior Art Rejections

Claims 15-23, 30-32, 35, 36 and 41 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,695,493 to Friedlander et al. (Friedlander). According to

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the Office Action, Friedlander discloses a composite strip comprising a layer of fibrous floor covering material, a mold layer formed of hot melt adhesive covering the entire back surface of the strip, with a thickness of 1-20 mil, and a release sheet on the attachment layer.

In distinction, claim 15 is directed to a covering for use on an exterior surface, comprising a fibrous layer having a back surface and a moldable layer **directly applied to the entire back surface of the fibrous layer** and having a bottom surface with an adhesive quality. The moldable layer is at least 5 mils thick between the back surface of the fibrous layer and the bottom surface. A release sheet is releasably secured to the bottom surface of the moldable layer. The fibrous layer, the moldable layer and the release sheet form a composite strip that is elongated with a predetermined length and has a predetermined width, the predetermined width being less than the predetermined length.

As previously explained in the Petition to Make Special filed with this application, Friedlander relates to a peel and stick carpet assembly that has an inner shape retaining web so that the carpet assembly can be pressed into a predetermined three dimensional contour for application onto an automobile panel. The carpet assembly is rolled into rolls of predetermined length. Friedlander's adhesive layer that has a release liner secured thereto is not directly applied to the entire back surface of the fibrous layer. It is applied to the shape retaining web, which in turn is adhesively secured to the fibrous layer. This is clearly seen in FIG. 1 and described in col. 6, line 44 through col. 7, line 26. Further, there is no mention of the relationship between the length and the width of the carpet assembly when rolled. To find anticipation, a prior art reference must disclose each and every feature of the claim. As Friedlander lacks at least the two features noted above, Friedlander cannot anticipate claim 15. Claim 15 is allowable.

Dependent claims 16-23 are allowable for at least the above reasons and for the additional features recited therein.

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Claim 30 is directed to a covering product for application to an upper surface of each of a plurality of elongated boards each having a pair of opposed sides and width measured between the opposed side edges. The covering product comprises an elongated strip of flexible floor covering material having a back surface and a width slightly less than the width of the elongated boards so that upon application the elongated strip lies between the opposed sides to leave a gap on both sides of the upper surface of the board. A moldable layer with an adhesive surface is applied directly to the back surface of the elongated strip of floor covering material for direct attachment of the back surface to an upper surface of one of the elongated boards by the adhesive surface. The elongated strip of floor covering material and the moldable layer are capable of being rolled longitudinally while remaining resilient. A release material is releasably secured to the adhesive surface and arranged to co-operate between the adhesive surface and the elongated strip of floor covering material to allow unrolling of the rolled strip and the adhesive surface for application of the moldable layer to one of the elongated boards. The strip possesses elasticity during the application.

As discussed above, Friedlander is silent as to the width of the carpet roll. Moreover, Friedlander lacks a moldable layer directly applied to the back surface of the strip of floor covering with a release material secured thereto. Further, Friedlander's carpet does not remain resilient and does not possess elasticity during application since it is formed in a three dimensional shape for application. For at least these reasons, Friedlander cannot be found to anticipate claim 30. Claim 30 is allowable.

Dependent claims 31, 32, 35, 36 and 41 are allowable for at least the above reasons and for the additional features recited therein.

It is further noted that Friedlander does not render claims 15, 30 or their dependent claims obvious as there is no suggestion in the prior art to eliminate the shape retaining web, especially as such elimination would destroy the function of Friedlander's invention.

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Claims 1-6, 13, 14, 33, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 5,204,155 to Bell et al. (Bell). The Office Action specifically notes that Friedlander's carpet has an impermeable foil barrier layer secured to the back surface of the fibrous layer and a moldable layer covering the foil barrier layer. Bell is added to teach of a moldable layer that is applied at a coating weight of between 185 and 600 gsm for the purpose of having a flooring that is sufficient to distribute compressive weight of objects placed on the face of the floor surface covering. It is asserted that it would have been obvious to provide such a moldable layer with such a coating weight in Friedlander to have a flooring that is sufficient to distribute the compressive weight of objects placed on the face of the flooring surface as taught by Bell.

Claim 1 recites a covering for use on an exterior surface, comprising a fibrous layer having a back surface and a moldable layer **directly applied to the entire back surface of the fibrous layer** and having a bottom surface with an adhesive quality. The moldable layer is applied at a volume of at least about 185 grams per square meter between the back surface of the fibrous layer and the bottom surface. A release sheet is releasably secured to the bottom surface of the moldable layer. The fibrous layer, the moldable layer and the release sheet form a composite strip that is elongated with a predetermined length and has a predetermined width, the predetermined width being less than the predetermined length.

As explained in the Office Action, Friedlander has a shape retaining web disposed between the carpet and the adhesive. Thus, the feature of the moldable layer directly applied to the back surface of the fibrous layer is entirely lacking in Friedlander.

Bell discloses a foam backed carpet having a series of layers between the carpet layer 14 and the bottom surface. In particular, Bell's carpet tile is formed of fabric 12 having tufted face 14, a thin precoat layer 16 of rubber latex, a first layer 18 of bitumen containing glass fiber or scrim sheet material 20, a closed cell foam layer 22, a second bitumen layer 24

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with tissue sheet material 26 therein, and a non-woven polyester or polypropylene backing layer 28. The layer directly applied to the back surface of the fibrous layer is the thin precoat layer 16. There is no moldable layer directly attached to the back surface of the fibrous layer with a release sheet attached thereto. In fact, there is no release sheet. (Col. 6, lines 6-27.) The bitumen layers are about 1300 g/m². Thus, Bell also lacks the claimed moldable layer directly applied to the back of the fibrous layer with a release sheet thereon.

Bell is cited as allegedly teaching of using a moldable layer with a coating weight of greater than 185 gsm. However, Bell merely discloses using an intermediate bitumen layer in a foam backed carpet tile of 1300 g/m². The object of Bell is to address issues of compressive force in foam backed carpeting. The Office Action asserts that to provide a layer with such thickness in Friedlander would have been obvious to distribute the compressive weight of objects placed on the face of the flooring. It is unclear how the addition of a thick bitumen layer in Friedlander would be an advantage or where such a suggestion would originate. Further, Friedlander's carpet is used for contoured automobile panels, so there would be no motivation to distribute compressive weight. Moreover, Bell's design addresses issues relating to foam backed carpet, but Friedlander does not include a foam layer so it there would be no motivation to address such issues in Friedlander's design.

The combination of Friedlander and Bell lacks several features of claim 1. Further, the combination is improper as there is no suggestion in the prior art for making the suggested modifications. It is noted that even if the suggested modifications could be properly made, all of the features of claim 1 would not be met by such a combination as explained above. Claim 1 is allowable.

Dependent claims 2-6, 13, 14, and claims 33 and 34, which depend from claim 30, are also not rendered obvious by Friedlander in view of Bell for the reasons above and for the additional features recited therein.

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Claims 7, 8, 12, 24, 25, 29 and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 6,426,129 to Kalwara et al. (Kalwara).

While claims 7, 8, and 12 depend from claim 1, which was rejected based on Friedlander as modified by Bell, only Kalwara is combined with Friedlander in the rejection of these dependent claims. Kalwara is cited for teaching of a composite strip having a predetermined width less than 12 inches, a predetermined length at least 25 feet and a release sheet with free edges. It is asserted that it would have been obvious to have provided the claimed lengths and widths in Friedlander's covering in order to have a release liner that is easy to disengage from the tacky surface of the adhesive layer as taught by Kalwara.

First, Friedlander does not disclose a moldable layer directly applied to the back surface of the fibrous layer. Second, with respect to claims 7, 8, and 12 Friedlander does not disclose the volume of at least 185 gsm. Kalwara does not remedy these deficiencies. So these features are not met by the asserted combination of prior art. Third, Kalwara is directed to an adhesive rubber article for use in the roofing industry. There is no suggestion in the prior art for why it would have been obvious for someone of ordinary skill in the floor covering art to look for roofing membranes for motivation to modify Friedlander's carpet panels. Absent proper motivation, a prima facie case of obviousness cannot be made. As such, claims 7, 8, 12, 24, 25, 29 and 40 are not rendered obvious over Friedlander in view of Kalwara and are patentable.

Claims 9-11, 27, 28 and 37-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Friedlander in view of U.S. Patent No. 3,937,640 to Tajima et al. (Tajima).

Again, while claims 9-11 depend from claim 1, which is rejected in view of Friedlander modified by Bell, only Tajima is combined with Friedlander in the rejection of

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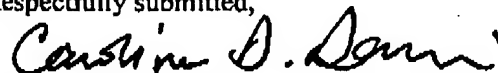
these dependent claims. Tajima is cited for teaching of a composite strip having a release sheet with a central release sheet.

First, Friedlander does not disclose a moldable layer directly applied to the back surface of the fibrous layer. Second, with respect to claims 9-11, Friedlander does not disclose the volume of at least 185 gsm. Tajima does not remedy these deficiencies. So these features are not met by the asserted combination of prior art. Third, claims 11, 28, and 39 recite that the central release strip overlaps the release strips on the edges, which is not shown by Tajima or addressed in the Office Action. Fourth, Tajima is directed to laminated bituminous roofing membranes. There is no suggestion in the prior art for why it would have been obvious for someone of ordinary skill in the floor covering art to look for roofing membranes for motivation to modify Friedlander's carpet panels. Absent proper motivation, a prima facie case of obviousness cannot be made. As such, claims 9-11, 27, 28, and 37-39 are not rendered obvious over Friedlander in view of Tajima and are patentable.

Claim 26 is not rejected in view of prior art. As such, it is assumed that claim 26 is allowable over the prior art of record.

It is respectfully submitted that the claims are allowable and that the application is in condition for allowance. A prompt notice to that effect is respectfully requested. Should further issues require resolution prior to allowance, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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